



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Assignee's Docket No.: 8771.00)
Group Art Unit: 3624)
Serial No.: 09/780,696)
Examiner: R. Weisberger)
Filing Date: February 9, 2001)
Title: Self Service Terminal)

APPEAL BRIEF
A Summary of Argument Begins on Page 5

The fee for this Brief may be billed to Deposit Account 14 - 0225, NCR Corporation.

CERTIFICATE OF MAILING

I certify that this document is addressed to Mail Stop AF, Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450, and will be deposited with the U.S. Postal Service, first class postage prepaid, on August 20, 2007.

Gregory A. Welte

1. REAL PARTY IN INTEREST

NCR Corporation.

2. RELATED APPEALS AND INTERFERENCES

None.

3. STATUS OF CLAIMS

Claims 30, 31, and 33 - 56 are pending, rejected, and appealed.

Claims 1 - 29 and 32 have been cancelled.

09/780,696
Art Unit 3624
Docket no. 8771.00

Claims 51, 54, 55, and 56 are allowable if re-written.

4. STATUS OF AMENDMENTS

An Amendment-After-Final is herewith submitted, which places claims into condition for allowance, consistent with the third full paragraph on page 3 of the Final Office Action.

It is not known at this time whether the Amendment will be entered.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Summary in Brief

In one form of the invention, a customer does not execute a transaction with an ATM, Automated Teller Machine, using the ATM's keypad, but instead utilizes a wireless communication device owned by the customer.

Summary in Detail

Figure 1 of the Specification shows Self-Service Terminals 14a and 14b, which take the form of ATMs. (Specification, page 9, lines 1 - 5.) The Figure shows a Personal Digital Assistant, PDA, 24, which is a personal communication device. (Specification, page 9, lines 8 - 10.) Figure 2 also shows an ATM 14.

The PDA 24 has a display screen which displays a series of screens which are similar to those displayed by the ATM.

09/780,696
Art Unit 3624
Docket no. 8771.00

(Specification, page 10, lines 4 - 6.) The PDA 24 communicates with the ATM 14 using an infra-red link, using an IR port 62 on the ATM. (Specification, page 10, lines 16 - 19.)

The display of the PDA 24, and the infra-red communication, allow the user of the PDA 24 to order the ATM to execute a transaction, such as dispensing currency. (Specification, page 10, lines 12 - 14.)

Mapping of Claim Elements in Independent Claims

Parenthetical phrases, in **bold typeface**, are inserted into the following claims, to identify matter in the Specification and Figures which supports the claim language adjacent said **bold, parenthetical typeface**.

30. A self-service financial terminal (**item 14a, Figure 1; item 14, Figure 2; page 9, lines 1 - 7**) comprising:

means for receiving a request from a wireless communication device (**ATM 14, Figure 2, including IrDA port 38 and processor 30; page 9, lines 13 - 20; page 10, line 10 et seq.**);
and

means for dispensing valuable media in response to a request received from a wireless communication device (**ATM 14, dispenser 32,**

09/780,696
Art Unit 3624
Docket no. 8771.00

processor 30, and related components, Figure 2; page 10, lines 1 - 15).

31. A terminal according to claim 30, further comprising means for enabling the terminal to be operable in a first mode in which a user may enter information using a user interface located on the terminal, and in a second mode in which a user may enter information using a portable user interface (**ATM 14, Figure 2, and related components; page 14, lines 24 - 29**).

33. A self service financial terminal comprising:
a transceiver which receives a request from a wireless communication device (**IrDA port 38, Figure 2, and related components; page 9, lines 16 - 20**); and
a dispenser which dispenses valuable media in response to a request received from a wireless communication device (**dispenser 32, Figure 2; page 10, lines 20 - 25**).

34. A method comprising:
receiving at a self-service financial terminal a request from a wireless communication device (**page 10, lines 20 - 21**); and
dispensing at the self-service terminal valuable media in response to a request received from a wireless

09/780,696
Art Unit 3624
Docket no. 8771.00

communication device (**page 10, lines 21 - 25**).

35. A method according to claim 34, further comprising enabling the terminal to be operable in a first mode in which a user may enter information using a user interface located on the terminal, and in a second mode in which a user may enter information using a portable user interface (**page 14, lines 24 - 29**).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether the rejections of claims 30, 31, and 33 - 56 are proper under 35 USC § 112.

Whether the rejections of claims 30, 31, 33 - 50, 52, and 53 are proper under 35 USC § 102(e).

7. ARGUMENT

SUMMARY OF ARGUMENT

Point 1

Claims 39, 45, and 51 state that the terminal dispenses currency. That has not been shown in Whigham.

Point 2

Claims 40, 46, and 52 state that "the valuable media comprise banknotes, telephone cards, or ski passes." That has not been

09/780,696
Art Unit 3624
Docket no. 8771.00

shown in Whigham.

Point 3

Claims 41, 47, and 53 state that the valuable media comprise a medium of exchange. A medium of exchange is used to later purchase goods or services. That has not been shown in Whigham.

Point 4

Claim 54 states that

- i) the SST comprises an automated teller machine,
- ii) the SST presents no keypad to a customer, and
- iii) the valuable media comprises currency.

These recitations have not been shown in Whigham.

Point 5

The independent claims state that a financial terminal dispenses "valuable media" (such as money or ski passes).

The Whigham reference shows a Coke machine.

The Final Office Action asserts that "information printed on the vended item" in Whigham corresponds to the claimed "valuable media."

However, that "information" in Whigham is **discarded** after the

09/780,696
Art Unit 3624
Docket no. 8771.00

item is unwrapped. That "information" is **trash**. That "information" is not "valuable media" as claimed.

Further, dependent claims recite specific types of "valuable media" which are not shown in Whigham (eg, claim 40: banknotes, telephone cards, or ski passes).

Also, the claims recite a "financial terminal." Clearly, that is a "terminal" (ie, device connected to a computer system) which performs a financial function. A "financial terminal" as claimed is not found in Whigham.

Point 6

Some Claims not Rejected Based on Art

Claims 51 and 54 - 56 have not been rejected under section 102, only under section 112. Therefore, they should be allowed, if the 112 - rejections are overcome.

The Final Office Action, page 3, states that these claims would be allowable. Appellant herewith submits an Amendment-After-Final, in an attempt to secure allowance. However, since Appellant does not know (1) what amendments are being requested by the PTO to overcome the 112 - rejections and (2) whether the Amendment-After-Final will be entered, Appellant herein argues the allowability of these claims, without further amendment.

09/780,696
Art Unit 3624
Docket no. 8771.00

112 - Rejections are Overcome

It is believed that this Brief successfully overcomes the 112 - rejections, because all such rejections (except one, relating to the term "automated teller machine") assert that the claim term "financial terminal" is vague and indefinite.

This Brief explains that the Office Action

- 1) conceptually removes that claim term from the claim, and
- 2) asserts that, **in isolation**, the claim term is vague and indefinite.

But that is incorrect procedure. The claim term is read **within its context**, within the claim. Claims are read as-a-whole.

Further, the term "terminal" has a standard dictionary-definition, which applies here. At worst, the term "financial" is non-limiting surplusage, which is not a basis for a 112 - rejection, based on the overall phrase "financial terminal."

Further still, other language of the claim sets forth the properties of the claim term, thereby further defining the (already defined) term.

Analogy

In principle, the situation is no different from a claim stating "A **device** which performs A, B, C, and D." The word "device" is not subject to rejection, on the grounds that, **in**

09/780,696
Art Unit 3624
Docket no. 8771.00

isolation, it is vague and indefinite.

When that term ("device") is within a claim, the remainder of the claim sets forth the properties of, or defines, the term "device." In this example, the "device" "performs A, B, C, and D."

A similar principle applies to "financial terminal" in the appealed claims. The rest of the claim defines the term.

Other Patents use "Financial Terminal" in Claims

Six previous US patents were uncovered in which the rejected phrase "financial terminal" occurs in the claims. Given that, it is incumbent on the PTO to provide an explanation as to why that term is unacceptable now.

Point 8

Claim 54 was rejected because it contains the term "automated teller machine" without a further definition of that term.

Appellant has found numerous patents which contain that same term, without a further definition. Further, that term has a well-known meaning.

END SUMMARY

09/780,696
Art Unit 3624
Docket no. 8771.00

ARGUMENT

ARGUMENT REGARDING 102 - REJECTIONS OF CLAIMS 30, 31, 33 - 50, 52, and 53

The claims listed in the heading immediately above were rejected on grounds of anticipation, based on Whigham, US Patent 6,584,309.

Whigham Reference

Whigham shows a vending machine, which dispenses soft drinks. He states that a customer can utilize a cell phone to cause the vending machine to dispense an item.

Point 1

All claims recite a **financial** terminal. Whigham shows a generic vending machine, which is not a **financial** terminal.

Appellant points out that the word "terminal," in the present context, refers to a device which connects to a computer system. This is a standard dictionary-definition, as explained below.

Thus, a **financial** "terminal" is such a terminal (connected to a computer system) which allows a user to execute a **financial** transaction. This conclusion results from a simple application of the English language.

Whigham fails to show such a device. He shows a Coke machine.

MPEP § 2131 states:

09/780,696
Art Unit 3624
Docket no. 8771.00

A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

No "financial terminal" is found in Whigham.

Point 2

The claims recite dispensing of "valuable media" to a customer.

The Final Office Action, beginning at the bottom of page 2, states that "the Examiner interprets valuable media to include any information printed on the vended item."

Appellant points out that the Whigham is clearly discussing a generic vending machine, which dispenses candy, gum, cigarettes, soft drinks, and so on. The Office Action, in effect, is stating that the **printing** on a wrapper/package/bottle (collectively termed "wrapper" herein) dispensed by the vending machine corresponds to the claimed "valuable media."

Appellant submits that common sense precludes this interpretation. Appellant points out that the wrapper is **discarded** as soon as the product contained therein is consumed.

Therefore, any printing on the wrapper cannot be considered as "valuable media," because the wrapper is considered trash.

Restated, a customer would not toss "valuable media" into the

09/780,696
Art Unit 3624
Docket no. 8771.00

trash. Yet that is **precisely** what the customer in Whigham does.

Restated again, the item **of value** to the customer in Whigham is the **contents** of the wrapper. It is the **contents** which the customer pays for, as again shown by the fact that the customer discards the wrapper when the contents are consumed.

Point 3

As Point 2 stated, the Office Action is asserting that the **information** on the label is the "valuable media."

Appellant points out that some information can be valuable, such as a trade secret, a customer list, and so on. However, the information in Whigham is obtainable free-of-charge, to any customer who visits a supermarket, and reads the label on a corresponding product which Whigham's machine dispenses.

That is, the information in Whigham is not protected by anybody (or at least such protection has not been shown). So nobody pays to obtain it.

Therefore, Appellant submits that, if the PTO is to rely on its assertion that the information in Whigham is actually "valuable media," the PTO must show that this information actually has value. For example, the PTO must show that somebody purchases this information, independent of the product which the information describes.

That has not been done.

09/780,696
Art Unit 3624
Docket no. 8771.00

Therefore, again, Appellant submits that any printing on the wrapper cannot be considered as "valuable media."

Point 4

The term "media" in "valuable media" clearly refers to a "medium of exchange." ("Media" is the plural of "medium.") The Specification, page 2, lines 21 - 22, provides some examples: "banknotes, stamps, telephone cards, ski passes, or such like."

In all these examples, the "media" are designed to be exchanged for goods or services at a later time.

That is not so in the case of Whigham. The printed matter in Whigham is part of a wrapper which is discarded, and which is not exchanged.

Whigham's printed matter is not a medium of exchange, as the term "media" implies. It is trash, once the associated product is consumed.

Point 5

It is possible that a vending machine can dispense stamps, which could be considered a medium of exchange. However, that has not been shown in the prior art.

Point 6

The claims in question all contain a recitation to the effect

09/780,696
Art Unit 3624
Docket no. 8771.00

that the self-service terminal receives a "request" from a wireless communication device.

Whigham requires a cell phone to dial a server, which then issues a "vend code" to a vending machine, causing the latter to dispense a product. (Column 1, lines 47 - 58; column 2, lines 33 - 54.) That operation does not correspond to the claim recitation just identified. Whigham's vending machine does not receive the request from a wireless communication device.

It is true that Whigham does state that the customer's cell phone can send a vend code directly to the vending machine. (Column 2, line 23 et seq.) However, in this case, Whigham does not state how the customer then pays for the vended product. Thus, in this case, Whigham is inoperative, and thus non-enabling.

For a reference to be anticipatory under section 102, the reference must be enabling. (See Patents by D. Chisum, sections 3.06(1)(a) and 304(1).)

Therefore, Appellant submits that

-- Whigham discloses an embodiment wherein a "server" issues the "vend code" to a vending machine. That does not show the claim recitation of a "wireless communication device" sending a "request" to a self-service terminal.

-- Whigham does mention a cell phone sending

09/780,696
Art Unit 3624
Docket no. 8771.00

a vend code directly to a vending machine.

But he does not state how the customer pays for the vended product in this case. Whigham is non-enabling for this case, and thus cannot anticipate.

Conclusion

Appellant submits that Whigham does not anticipate the independent claims.

re: SELECTED DEPENDENT CLAIMS

Claims 36, 42, and 48

These claims state that a keypad is not present. Whigham states that a keypad can be provided. (Column 2, line 3.) Thus, Whigham does not anticipate.

As explained later, the Office Action asserts that Whigham's keypad is "optional." Appellant submits that this is not entirely correct.

What is "optional" is a keypad which accepts the "vend code" when punched in by the customer. (Column 2, line 3.) That optionality does not imply that a keypad is absent from Whigham's other embodiments, wherein this "vend code" is entered in another manner.

Appellant asks: if the keypad were completely absent, how does

09/780,696
Art. Unit 3624
Docket no. 8771.00

an ordinary customer select an item to be vended ?

Further, Appellant points out that many vending machines contain keypads, by which a person selects an item, such as by pressing (A, 6).

Therefore, Appellant submits that the claimed absence of a keypad is not found in Whigham.

The PTO is relying on the doctrine of inherency in asserting that Whigham teaches an embodiment lacking a keypad. MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

No such "basis in fact and/or technical reasoning" has been provided, showing why Whigham's vending machine necessarily lacks a keypad.

Claims 37, 43, and 49

These claims state that a video display is not present.

Whigham states that his vending machine displays the products which are available. (Column 2, line 58 et seq.) He states that "products" also include services. (Column 3, line 54 et seq.)

09/780,696
Art Unit 3624
Docket no. 8771.00

He states that information is displayed on, or adjacent to, the vending machine, which information describes the products available, and how to purchase them. (Column 5, line 56 et seq.)

Appellant points out that it is well known that the products contained in, and their prices, periodically change. Thus, this "information" must periodically change.

Appellant thus submits that Whigham can reasonably be interpreted as including a video display, to accommodate the changing products/prices. That is contrary to these claims.

Claims 39, 45, and 51

These claims state that the terminal dispenses currency. That has not been shown in Whigham.

It may be thought that Whigham's Coke machine dispenses change in a transaction. However, when the customer makes a purchase using a cell phone, there is no need for change.

Claims 40, 46, and 52

These claims state that "the valuable media comprise banknotes, telephone cards, or ski passes." That has not been shown in Whigham.

Claims 41, 47, and 53

These claims state that the valuable media comprise a medium

09/780,696
Art Unit 3624
Docket no. 8771.00

of exchange. A medium of exchange is used to later purchase goods or services. That has not been shown in Whigham.

Claim 54

Claim 54 states that

- i) the SST comprises an automated teller machine,
- ii) the SST presents no keypad to a customer, and
- iii) the valuable media comprises currency.

These recitations have not been shown in Whigham.

Claim 55

The discussion of claims 37, 43, and 49 applies here.

Claim 56

Claim 56 states that the wireless device displays screens of options offered by the ATM. That has not been shown in Whigham.

ARGUMENT REGARDING 112 - REJECTIONS OF CLAIMS 30, 31, AND 33 - 56

Point 1

The Final Office Action asserts that the claimed term "financial terminal" is "vague and indefinite with respect to what

09/780,696
Art Unit 3624
Docket no. 8771.00

essential structure is inherent thereto." However, several problems exist in this rejection.

Problem 1

The Final Office Action selects a **single term** ("financial terminal"), and asserts that, **in isolation**, the term is "vague and indefinite."

That is improper procedure. It is axiomatic that claims are read as-a-whole. In this case, other parts of the claims set forth characteristics of the "financial terminal," and thus add definiteness. Those other parts cannot be ignored, as the Office Action is doing.

By analogy, a claim may recite "A **device** which performs A, B, C, and D." That claim is not subject to rejection, on the grounds that the word "device," in isolation, is vague and indefinite. The claim is read as-a-whole. This exemplary claim defines the "device" by stating that it performs A through D.

Similarly, Appellant's claims recite a "financial terminal," and then set forth defining characteristics of that "terminal."

The fact that "financial terminal" is asserted to be indefinite, when read in the abstract sense, (which is not so: see below) is not relevant.

The question is whether a definite financial terminal is set forth in the claims, taken as-a-whole.

09/780,696
Art Unit 3624
Docket no. 8771.00

Problem 2

Appellant submits that the PTO's assertion is incorrect. The undersigned attorney's desk dictionary gives one definition of "terminal"

terminal . . . a combination of a keyboard and output device (as a video display unit) by which data can be entered into, or output from, a computer or electronic communication system.

Therefore, "terminal," by itself, has a clear meaning.

Thus, at worst, the term "financial" in the phrase "financial terminal" is merely non-limiting surplusage. That is not a basis for rejection of a claim.

Further, the term "financial" is not really surplusage. A "financial" "terminal" is plainly a "terminal" which performs a financial transaction.

Problem 3

On August 20, 2007, the undersigned attorney did a Google search on the phrase "financial terminal." Numerous hits were obtained.

One hit was the "Electronic Financial Terminal Policy" of the State of Louisiana, Revised December 13, 2006. (See WWW.ofi.state.la.us/eft-di-01-2006.pdf.) That Policy states:

09/780,696
Art Unit 3624
Docket no. 8771.00

An EFT¹ includes, but is not limited to, automated teller machines, cash dispensing machines, script machines, automated loan machines, point of sale terminals, or other similar electronic devices.

Thus, the State of Louisiana gives a definition (by example) of electronic **financial terminals**.

Problem 4

On August 20, 2007, the undersigned attorney performed a search of the PTO's web site, using the following query:

ACLM/("financial terminal").

This query requested patents in which the claims contain the phrase "financial terminal."

The query returned the following claims, in the following patents. Every patent contains the phrase "financial terminal."

PATENT 7,083,089

9. A method for off-line Personal Identification Number (PIN) verification using a smart card accessed on an off-line terminal, the method comprising: creating a unique secret key for an enrolled smart card using a card issuer private key; generating signatures on an entered PIN using the unique key, the signatures being verifiable by the smart card and/or the terminal; and enabling a **FINANCIAL TERMINAL** to perform a challenge-response

¹ Electronic Financial Terminal

protocol to determine whether the smart card and an entered transaction PIN' are valid for a financial transaction to proceed.

PATENT 6,968,321

16. A system for providing remote operator interface with a self-service financial transaction terminal, comprising: a plurality of web-based, customer-inaccessible applications for remote operator functions provided on the self-service financial transaction terminal, said remote operator functions being selected from a group of remote operator functions consisting of a reboot function, a stop function, a stop immediately function, a start function, a configure function, a view configuration function, a view software release information function, a view status function, a view integrated network controller and host connection status function, a start peruse function, a view event logs function, a view event logs in real-time function, a write event logs to file function, a start back administration function, a start command shell function, and an initialize personal identification number encryption keys function; a remote operator interface client computing device adapted for allowing the remote operator to access the self-service financial transaction terminal via a browser application of the remote operator interface client computing device; and said self-service financial transaction terminal being adapted for receiving the remote operator's entry of a user identification from the remote operator interface client computing device, for displaying a menu of the self-service financial transaction terminal operator functions for the remote operator at the remote operator interface client computing device, means for receiving the remote operator's selection of at least one of the self-service financial transaction terminal operator functions from the remote operator

09/780,696
Art Unit 3624
Docket no. 8771.00

interface client computing device, and for allowing the remote operator at the remote operator interface client to access one of the plurality of web-based, customer-inaccessible applications on the self-service financial transaction terminal for the selected self-service **FINANCIAL TERMINAL** operator function.

PATENT 6,164,529

1. A self service **FINANCIAL TERMINAL** for enabling a user to carry out a transaction, the self service **FINANCIAL TERMINAL** comprising:

a reader/writer for receiving a portable digital storage device comprising a floppy diskette from the user;

a processor for controlling the reader/writer; and a currency dispenser for delivering currency to the user.

PATENT 6,097,606

1. A **FINANCIAL TRANSACTION TERMINAL** for cooperating with smart cards said terminal comprising a housing enclosing electronic circuitry and including a visual display and a keypad, said housing including a slot entry for receiving and forming an electronic circuit between a received smart card and said enclosed electronic circuitry, said keypad allowing a user to enter information into said **FINANCIAL TERMINAL**, and at least one accessible user secure module provided in an access port of said housing, said financial transaction terminal including an electrical switch seal arrangement biased by said housing to form an electrical seal at a plurality of points spaced about the perimeter of said access port whereby both access to said user secure module and security about said port are provided.

PATENT 5,852,977

1. A self-service **FINANCIAL TERMINAL** for producing a valuable document to be delivered to a customer at the self-service **FINANCIAL TERMINAL**, the self-service **FINANCIAL TERMINAL** comprising:

a card reader for receiving a user identifying card from a customer to verify the identity of the customer to allow the customer to gain access to services provided by the self-service terminal;

a container for storing sheets on which information is to be printed to provide valuable documents to be delivered to customers;

a first printer mechanism for printing information onto a sheet which has been transported from the container to the first printer mechanism to produce a valuable document;

a second printer mechanism for printing an indicia of invalidity onto a valuable document which has been produced at the first printer mechanism and transported from the first printer mechanism to the second printer mechanism;

an input device for receiving inputs from the customer to provide information to be printed onto a sheet which has been transported from the container to the first printer mechanism to produce a valuable document; and

a processor for (i) controlling the first printer mechanism to print information onto a sheet which has been transported from the container to the first printer mechanism in response to inputs received from the customer via the input device requesting that a valuable document be produced and delivered to the customer, and (ii) controlling the second

printer mechanism to print an indicia of invalidity onto the valuable document which has been produced at the first printer mechanism and transported from the first printer mechanism to the second printer mechanism to render the valuable document invalid in response to inputs received from the customer via the input device indicating that the valuable document has incorrect information printed thereon.

PATENT 5,752,239

6. A self-service **FINANCIAL TERMINAL** for allowing a customer of a financial institution to carry out a financial transaction, the self-service **FINANCIAL TERMINAL** comprising:
a display;
a processor for (i) providing a background image representative of the financial institution on the display, and (ii) providing an animated sprite representative of the customer on the display and movable between different positions within the background image on the display; and
a manually operable control device for (i) controlling the processor to control movement of the animated sprite from a first position within the background image on the display to a second position within the background image on the display to select a financial transaction to be carried out when the customer manually operates the control device at a first time, and (ii) controlling the processor to complete carrying out the selected financial transaction when the animated sprite is at the second position within the background image on the display and the customer manually operates the control device at a second time which is later than the first time.

In view of the acceptance by the PTO of the term "financial terminal" in the above six patents, Appellant submits that the

09/780,696
Art Unit 3624
Docket no. 8771.00

Examiner has an obligation to explain why **that same term** is unacceptable in the present case.

The Examiner's naked assertion that the term is "vague and indefinite" etc. is not sufficient.

Problem 5

The Office Action asserts that the phrase "financial terminal" must specify "what essential structure is inherent thereto." Appellant points out that this is not the test under section 112.

Section 112 states, in part:

...
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

There is no requirement of specifying "what essential structure is inherent" in a specific claim phrase.

Further, as explained above, even if this "essential structure" is required, the claim **as-a-whole** is used to supply it. The claims in question set forth the characteristics of the "financial terminal."

From another point of view, the PTO is extracting the phrase "financial terminal" from the context which defines the behavior, or characteristics, of the "financial terminal." Then, the PTO asserts that the phrase, **in the abstract and out of context** is

09/780,696
Art Unit 3624
Docket no. 8771.00

vague and indefinite.

If Appellant were to add the "essential structure" to the claim, that would not prevent the PTO from repeating this (erroneous) process. The PTO could still extract the phrase "financial terminal" from its **new** context, and assert that, **in the abstract and out of context**, the phrase is vague and indefinite.

Point 2

The Final Office Action rejected claim 54, on the grounds that "it is not clear what components are essential to an automatic teller machine" (ie, ATM).

Response 1

On August 20, 2007, the undersigned attorney did a Google search of the term "ATM." At least two definitions of Automated Teller Machine were returned, on the first page of hits. Appellant submits that this search clearly indicates that the phrases "ATM" and "Automated Teller Machine" have established definitions.

A claim is not required to repeat those definitions.

Response 2

The Specification, beginning on page 9, line 13, describes the components of an exemplary ATM, thereby providing one definition of the term.

09/780,696
Art Unit 3624
Docket no. 8771.00

If a term in a claim is undefined, one resorts to the Specification for a definition. MPEP § 2106(II)(C) states:

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.

MPEP § 2111 states:

PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions OR OTHERWISE that may be afforded by the written description contained in applicant's specification.

MPEP § 2173.05(a) states:

During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification.

Response 3

Appellant submits that the rejection is based on an incorrect premise. The premise is that the claim must set forth the "essential" "components" of an ATM. More generally, the rejection is asserting that every term in a claim must be accompanied by the "essential" "components" of that term.

The undersigned attorney is unaware of any such requirement,

09/780,696
Art Unit 3624
Docket no. 8771.00

and requests a citation of authority in support of the Examiner's position.

In this connection, Appellant points out that the Examiner's position is (1) contrary to established PTO policy and (2) being inconsistently applied.

As to contrariness to policy, Appellant points out that MPEP § 2111 states:

PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions OR OTHERWISE that may be afforded by the written description contained in applicant's specification.

That is, this MPEP section states that the "words" of a claim are given "the broadest reasonable meaning" "in their ordinary usage as . . . understood by one" skilled in the art.

This MPEP section **DOES NOT** state that each word must set forth the "essential" "components" of the item to which it refers.

As to inconsistent application, Appellant points out that the Examiner is selecting some claim terms, and requiring them to be accompanied by "essential" "components" or "structure," while not applying this requirement to other claim terms.

For example, claim 50 recites a "portable communication device." No objection was registered to that term.

09/780,696
Art Unit 3624
Docket no. 8771.00

Response 4

The Office Action, in essence, is objecting to the term "Automated Teller Machine" in a claim, without a further definition of that term.

On August 20, 2007, the undersigned attorney did a search of the PTO's web site, using the query "ACLM/(automated and teller)". This search intended to retrieve patents containing the words "automated" and "teller" in the claims.

The search produced 387 hits. A sampling of four hits is the following:

PATENT 7,252,276

8. In combination, an **AUTOMATED TELLER MACHINE** and a plinth having a base, a support on which a device is to be supported and at least three support legs supporting the plate above the base, wherein each support leg is adapted to be mounted on the base in different orientations to provide for different heights of the support plate relative to the base.

PATENT 7,251,626

3. At least one article including computer executable instructions operative to cause at least one computer to carry out a method comprising: (a) producing through operation of at least one computer in an **AUTOMATED TELLER MACHINE** (ATM) including a currency dispenser, at least one markup language document including indicia corresponding to status of at least one transaction function device of the ATM; and

09/780,696
Art Unit 3624
Docket no. 8771.00

(b) operating the at least one computer of the ATM to enable a device outside the ATM to access the at least one markup language document.

PATENT 7,251,608

11. A method of operating a delivery service, the method comprising: receiving a mail piece addressed to an entity and including postage indicia indicating an initial value; determining a cost for delivering the mail piece to the entity; modifying the postage indicia to indicate a remaining value wherein the remaining value indicates the initial value reduced by the cost for delivering the mail piece, wherein the postage indicia with the remaining value is a negotiable instrument configured to allow multiple people to negotiate and trade the postage indicia between each other before the postage indicia is redeemed with an **AUTOMATED TELLER MACHINE** (ATM); delivering the mail piece to the entity; and compensating a particular entity that presents the postage indicia for the remaining value indicated by the postage indicia without requiring a data center to dispatch the remaining value, wherein the **AUTOMATED TELLER MACHINE** (ATM) processes the postage indicia to determine the remaining value and disburses cash in the amount equal to the remaining value.

PATENT 7,249,761

18. The apparatus according to claim 10 and further including an **AUTOMATED TELLER MACHINE** (ATM), wherein the ATM includes a currency note dispenser, wherein the presenter is in the ATM, wherein the presenter comprises a currency note presenter, wherein the currency note presenter is operative to present at least one currency note to a user of the ATM during a currency note dispensing transaction.

09/780,696
Art Unit 3624
Docket no. 8771.00

In view of

- 1) the acceptance by the PTO of the term "automated teller machine" in the above six patents without further definition, and
- 2) the likely acceptance of the same term in over 300 other patents uncovered in the search,

Appellant submits that the Examiner has an obligation to explain why **that same term** is unacceptable in the present case.

Response 5

Appellant submits that the claim does set forth the essential elements of one type of ATM. It dispenses cash in response to a request. The claim says that.

Response to Final Office Action

Point 1

The Final Action, page 3, asserts that Whigham, column 1, lines 14 - 26 and 54 - 58, shows the first recitation of claims 33 and 34. However, those passages, and a discussion extending from those passages to column 3, line 35, state that Whigham does the following.

09/780,696
Art Unit 3624
Docket no. 8771.00

- 1) A customer dials a telephone number printed on Whigham's vending machine, and the customer designates a product. This is the customer's "request." (Column 3, line 10.) This telephone number belongs to a remote server.
- 2) The server sends a "vend code" to the customer's telephone, which relays the "vend code" to the vending machine. The "vend code" is a secret number, which the customer does not know, and which only the server and the vending machine recognize.

Thus, the customer's telephone in Whigham is merely a relaying agent. The customer's telephone does not originate the "vend code." Nor can the vending operation succeed if the server is inoperative, and cannot generate the "vend code."

The "vend code" is transmitted to the vending machine by the **joint, cooperative operation** of the server, together with the customer's telephone.

Further, the actual request, made by the customer, was made to the server, as explained above.

Given the foregoing, Appellant submits that this is a case of accidental anticipation, as to the first paragraphs of claims 33 and 34. "Accidental anticipations" are those which occur only

09/780,696
Art Unit 3624
Docket no. 8771.00

under unusual circumstances, and do not constitute anticipations under section 102. (See Law of Patents, by D. Chisum, §§ 3.03 and 3.03 (2).)

Point 2

The Office Action, page 3, line 2, asserts that claims 31 and 35 are shown in Whigham.

Appellant points out that the claims state that "information" is "entered." "Entered" into what? Clearly, into the "terminal."

In Whigham, as explained above, the customer's telephone calls a "server." Any information "entered" is given to the "server." But that information does not reach the vending machine. Only the "vend code" does, which is different information.

Point 3

The Office Action, page 3, first line of first paragraph, ignores "financial terminal," on the grounds that the term does not appear in the body of the claim. That is not allowed. The entire claim must be applied.

Further, even if the phrase is ignored, numerous claim recitations are still not found in the references, as explained above.

Point 4

09/780,696
Art Unit 3624
Docket no. 8771.00

Claim 36 recites an absent keypad. As to the optional keypad in Whigham, the rejection is thus obviousness-type, and not anticipation type.

That is, the Office Action must show a teaching for eliminating the keypad in Whigham.

Further, claim 36 states that the "terminal" lacks a keypad. No "terminal," as defined by a dictionary, is found in Whigham, let alone a "financial terminal."

Still further, as explained above, Whigham does not actually say that the keypad is optional. What is optional is a keypad into which the customer punches the "vend code," and which relays the "vend code" to some circuit which responds.

That does not imply that a keypad is absent in Whigham's other embodiments. In fact, many vending machines have keypads. The PTO is relying on Inherency, as explained above, but without providing a reason why the keypad is necessarily absent in the other embodiments.

Point 5

As to the last three sentences of the first full paragraph on page 3 of the Office Action, Appellant points out that the claims in question recite characteristics of the "terminal."

One of these sentences states:

09/780,696
Art Unit 3624
Docket no. 8771.00

The applicant has not expressly claimed that the terminal comprise[s] the currency, bank notes, or ski passes.

Appellant points out that, even if that be true, that is not relevant. Parent claims state that the terminal dispenses "valuable media." The dependent claims in question state that the "valuable media" "comprises" "banknotes" (for example).

Appellant is not required to state that the "banknotes" are **part of** the terminal. The dependent claims set forth further characteristics of a product (valuable media) which the terminal delivers. Those characteristics are not required to be part of the terminal.

One of the sentences states that Official Notice is taken that stamps are sold in vending machines. Appellant points out that this is not relevant in an anticipation rejection. If the Noticed subject matter is to be combined with Whigham, then the rejection becomes an obviousness rejection, in which different rules apply.

Point 6

The Office Action is self-contradictory.

On the one hand, it asserts that it can ignore the "financial terminal" recitation. (First sentence, first full paragraph, page 3.)

On the other hand, it asserts that the claims relate to a

09/780,696
Art Unit 3624
Docket no. 8771.00

"terminal," but that certain claim recitations are not said to be part of the "terminal." (Third sentence, first full paragraph, page 3.)

That is, the PTO ignores a claim recitation when it assists its conclusion, but then invokes that same recitation, when it wants to ignore other claim recitations (on the grounds that the others are not part of the terminal).

Stated again: the PTO ignores some claim recitations, on the grounds that they are not recited as part of a "terminal," but then the PTO states that the "terminal" is not part of the claims.

As a minimum, that is circular reasoning.

09/780,696
Art Unit 3624
Docket no. 8771.00

CONCLUSION

Appellant requests that the Board reverse all rejections and objections, and pass all claims to issue.

Respectfully submitted,



Gregory A. Weite
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 3
Dayton, OH 45479
August 20, 2007
(937) 445 - 4956

ATTACHMENTS: -- CLAIMS APPENDIX,
-- STATEMENT THAT NO EVIDENCE APPENDIX IS ATTACHED,
and
-- STATEMENT THAT NO RELATED PROCEEDINGS APPENDIX
IS ATTACHED

8. CLAIMS APPENDIX

30. A self-service financial terminal comprising:
means for receiving a request from a wireless
communication device; and
means for dispensing valuable media in
response to a request received from a wireless
communication device.

31. A terminal according to claim 30, further comprising
means for enabling the terminal to be operable in a first mode in
which a user may enter information using a user interface located
on the terminal, and in a second mode in which a user may enter
information using a portable user interface.

33. A self service financial terminal comprising:
a transceiver which receives a request from a wireless
communication device; and
a dispenser which dispenses valuable media in response
to a request received from a wireless communication
device.

34. A method comprising:
receiving at a self-service financial terminal a request
from a wireless communication device; and

09/780,696
Art Unit 3624
Docket no. 8771.00

dispensing at the self-service terminal valuable media in response to a request received from a wireless communication device.

35. A method according to claim 34, further comprising enabling the terminal to be operable in a first mode in which a user may enter information using a user interface located on the terminal, and in a second mode in which a user may enter information using a portable user interface.

36. Self-service terminal according to claim 30, wherein the terminal presents no keypad to a customer.

37. Self-service terminal according to claim 30, wherein the terminal presents no video display to a customer.

38. Self-service terminal according to claim 36, wherein all communication between the portable communication device and the terminal passes through a wireless communication port on the terminal.

39. Self-service terminal according to claim 36, wherein the valuable media comprise currency.

09/780,696
Art Unit 3624
Docket no. 8771.00

40. Self-service terminal according to claim 36, wherein the valuable media comprise banknotes, telephone cards, or ski passes.

41. Self-service terminal according to claim 30, wherein the valuable media comprise at least one medium of exchange.

42. Self-service terminal according to claim 33, wherein the terminal presents no keypad to a customer.

43. Self-service terminal according to claim 33, wherein the terminal presents no video display to a customer.

44. Self-service terminal according to claim 42, wherein all communication between the portable communication device and the terminal passes through a wireless communication port on the terminal.

45. Self-service terminal according to claim 42, wherein the valuable media comprise currency.

46. Self-service terminal according to claim 42, wherein the valuable media comprise banknotes, telephone cards, or ski passes.

47. Self-service terminal according to claim 33, wherein the

09/780,696
Art Unit 3624
Docket no. 8771.00

valuable media comprise at least one medium of exchange.

48. Method according to claim 34, wherein the terminal presents no keypad to a customer.

49. Method according to claim 34, wherein the terminal presents no video display to a customer.

50. Method according to claim 48, wherein all communication between the portable communication device and the terminal passes through a wireless communication port on the terminal.

51. Method according to claim 48, wherein the valuable media comprise currency.

52. Method according to claim 48, wherein the valuable media comprise banknotes, telephone cards, or ski passes.

53. Method according to claim 34, wherein the valuable media comprise at least one medium of exchange.

54. Self-Service Terminal, SST, according to claim 30, wherein

i) the SST comprises an automated teller

09/780,696
Art Unit 3624
Docket no. 8771.00

machine,

- ii) the SST presents no keypad to a customer,
and
- iii) the valuable media comprises currency.

55. SST according to claim 54, wherein the SST presents no video display to the customer.

56. SST according to claim 55, wherein the wireless device displays one or more screens which display options available in the ATM, including one or more cash withdrawal options.

09/780,696
Art Unit 3624
Docket no. 8771.00

9. EVIDENCE APPENDIX

None.

09/780,696
Art Unit 3624
Docket no. 8771.00

10. RELATED PROCEEDINGS APPENDIX

None.